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JUL 21 2000

In re Application of  
BRIESKORN, JURGEN, *et al.*  
Application No. 09/281,695  
Filed: 03/30/1999  
For: COMMUNICATIONS SYSTEM FOR THE  
CONTROL OF A COMMUNICATIONS

SPECIAL PROGRAMS OFFICE  
DAC FOR PATENTS  
DECISION REFUSING STATUS  
UNDER 37 C.F.R. §1.47(a)

This is in response to the Petition Under 37 C.F.R. §1.47(a) filed on August 25, 1999.

### HISTORY

The above-identified application was filed on March 12, 1999 naming Jürgen Brieskorn, Markku Korpi, Michael Sassin, and Shmuel Shaffer as joint inventors. However, the declaration was not properly signed by all co-inventors. Accordingly, a notice to file missing parts (hereinafter "the notice") was mailed to the address of record on April 20, 1999. Petitioner then filed his response to the notice on August 25, 1999.

### LAW

*§ 1.47 Filing when an inventor refuses to sign or cannot be reached.*

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(l) and the last known address of the nonsigning inventor. The Patent and Trademark Office shall, except in a continued prosecution application under § 1.53(d), forward notice of the filing of the application to the nonsigning inventor at said address and publish notice of the filing of the application in the Official Gazette. The nonsigning inventor may subsequently join in the application on filing an oath or declaration complying with §1.63.

### ANALYSIS

When analyzed in light of the rule, this petition is lacking in three respects.

### FEES

The notice to file missing parts noted that a surcharge of \$130.00<sup>1</sup> is required for a complete response to the notice. While the required petition fee of \$130.00 has been submitted with this petition, the required surcharge was not. Therefore, on that individual ground, this petition does not properly reply to the notice to file missing parts. Unfortunately, this is not the only aspect of this petition that is lacking.

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<sup>1</sup> 37 C.F.R. §1.16(e)

### **PROOF OF DILIGENT EFFORTS TO LOCATE THE ABSENT CO-INVENTOR**

Petitioner's proof of the pertinent facts pertaining to the diligent efforts made to locate the absent co-inventor consists of the following allegation:

"In a telephone call on August 11, 1999, the assignee of the above-identified application informed counsel that the fourth-named joint inventor could not be reached to sign the declaration."

Petitioner is urged to note the M.P.E.P. 409.03(d) (Proof of Unavailability or Refusal), which states:

"Where inability to find or reach a nonsigning inventor 'after diligent effort' is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made...[t]he affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. *Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.*"  
Emphasis added.

Given the above reference, it appears that Petitioner's statement cannot meet the required standard of proof that the non-signing inventor(s) could not be found. Petitioner's statement is not a description of the exact facts; it is a conclusion based on hearsay. Furthermore, no documentary evidence has been provided to bolster Petitioner's declaration. Therefore, Petitioner has not satisfied the requirement of Rule 1.47 of supplying a declaration "accompanied by a petition including proof of the pertinent facts."<sup>2</sup>

### **UNSIGNED DECLARATION**

Finally, it should be noted that while Petitioner did submit a new declaration, it has not been signed by any inventor, thus providing a third possible basis for dismissal of this petition. The notice to file missing parts of application noted that the declaration was unsigned, and Petitioner has certainly not responded to that deficiency with the submission of this declaration that has no signatures on it whatsoever.

### **DECISION**

This petition is accordingly *dismissed*.

Further correspondence with respect to this matter should be addressed as follows:

By mail:                      Assistant Commissioner for Patents  
                                    Box DAC  
                                    Washington, D.C. 20231


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<sup>2</sup> 37 C.F.R. §1.47(a).

By FAX: (703) 308-6916  
Attn: Special Program Law Office

By hand: Crystal Plaza Four, Suite 3C23  
2201 S. Clark Place  
Arlington, VA

Telephone inquiries related to this decision should be directed to Petitions Attorney  
Scott Ledford at (703) 306-5593.

  
Office of Petitions  
Office of the Deputy Assistant Commissioner  
for Patent Policy and Projects